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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,396	11/15/2001	Susann Marie Keohane	AUS920010879US1	7309

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EXAMINER

STORK, KYLE R

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 05/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/998,396	Applicant(s) KEOHANE ET AL.	
	Examiner Kyle R Stork	Art Unit 2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This final office action is in response to the amendment filed 8 February 2005.
2. Claims 1-20 are pending. Claims 1, 4, 7, and 10 are independent claims. Claims 13-20 are new claims added by the amendment. The rejections of claims 1, 3, 4, 5, 7, 9, 10, and 12 under 35 U.S.C. 102(b) and the rejection of claims 2, 5, 8, and 11 under 35 U.S.C. 103(a) as being anticipated by Microsoft® Word® have been withdrawn as necessitated by the amendment.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1, 4, 7, 10, 13, 15, 17, and 19 are rejected under 35 U.S.C. 102(a) as being anticipated by Adobe GoLive™ 5.0 User Guide (2000, hereafter Adobe).

As per independent claim 1, Adobe discloses the method of displaying a document having at least one section that is to be highlighted based on an intended user comprising the steps of:

- Displaying the document (pages 109-110: Here, viewing options for the display of a document can be set)
- Displaying at least one button with the document, the at least one button being associated with the at least one section of the document and indicating the

intended user (page 109-110, steps 11-12: Here, a user can assert a button to highlight all items tagged with a specific class, ID, or tags. As the applicant discloses in paragraphs 0037-0038 of the specification, the highlighting occurs between specific HTML tags. Adobe similarly will highlight sections of a displayed document between specified tags or having a specified ID)

- Highlighting the at least one section of the document when the at least one button is asserted (page 109-110, steps 11-12)

As per independent claim 4, the applicant discloses the limitations similar to those in claim 1. claim 4 is similarly rejected under Adobe.

As per independent claim 7, the applicant discloses the limitations similar to those in claim 1. claim 7 is similarly rejected under Adobe.

As per independent claim 10, the applicant discloses the limitations similar to those in claim 1. claim 10 is similarly rejected under Adobe.

As per dependent claim 13, Adobe discloses the method wherein the at least one section to be highlighted is within a pair of tags (page 109-110, steps 11-12).

As per dependent claim 15, the applicant discloses the limitations similar to those in claim 13. claim 15 is similarly rejected under Adobe.

As per dependent claim 17, the applicant discloses the limitations similar to those in claim 13. claim 17 is similarly rejected under Adobe.

As per dependent claim 19, the applicant discloses the limitations similar to those in claim 13. claim 19 is similarly rejected under Adobe.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-3, 5-6, 8-9, 11-12, 14, 16, 18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adobe in further in view of Microsoft® Word® (citations for claims 2-3, 5-6, 8-9, and 11-12 refer to screenshots provided with the office action of 22 September 2004; citations for claims 14, 16, 18, and 20 refer to new screenshots provided with this office action; hereafter Word).

As per dependent claim 2, Adobe discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Adobe fails to specifically disclose the method wherein highlighting the section entails graying out the document except the section. Word discloses the method of graying out the document in sections not currently selected (Figure 5: Here, the header/footer of the document is selected and the body of the text is grayed out accordingly).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Adobe's method with Word's method, since it would have allowed a user to see a greater contrast between the selected text which is highlighted and the unselected text which is grayed out.

As per dependent claim 3, Adobe discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Adobe fails to specifically

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disclose the method wherein highlighting the section entails displaying the section in a different color. Word discloses the method wherein highlighting the section entails displaying the section in a different color (Figure 4).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Adobe's method with Word's method, since it would have allowed a user to see a greater contrast between highlighted text and normal text.

As per dependent claim 5, the applicant discloses the limitations similar to those in claim 2. claim 5 is similarly rejected under Adobe.

As per dependent claim 6, the applicant discloses the limitations similar to those in claim 3. claim 6 is similarly rejected under Adobe.

As per dependent claim 8, the applicant discloses the limitations similar to those in claim 2. claim 8 is similarly rejected under Adobe.

As per dependent claim 9, the applicant discloses the limitations similar to those in claim 3. claim 9 is similarly rejected under Adobe.

As per dependent claim 11, the applicant discloses the limitations similar to those in claim 2. claim 11 is similarly rejected under Adobe.

As per dependent claim 12, the applicant discloses the limitations similar to those in claim 3. claim 12 is similarly rejected under Adobe.

As per dependent claim 14, Adobe discloses the limitations similar to those in claim 1, and the same rejection is incorporated herein. Adobe fails to specifically disclose the method wherein when the at least one button is asserted, a string is sent to

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a search engine, the string indicating the tags for which the search engine is to search.

Word discloses the method wherein when the at least one button is asserted, a string is sent to a search engine, the string indicating the information for which the search engine is to search (Figure 7: Here, a word is entered into the "Find" search box. The search engine then searches the document to find the next data item matching the search string).

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to have combined Adobe's method with Word's method, since it would have allowed a user to easily highlight section based upon a user specified search.

As per dependent claim 16, the applicant discloses the limitations similar to those in claim 14. claim 16 is similarly rejected under Adobe.

As per dependent claim 18, the applicant discloses the limitations similar to those in claim 14. claim 18 is similarly rejected under Adobe.

As per dependent claim 20, the applicant discloses the limitations similar to those in claim 14. claim 20 is similarly rejected under Adobe.

Response to Arguments

7. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

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As detailed above, the Adobe reference has been added to address the applicant's claimed amendments.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Keohane et al. (US 2003/0001891): Discloses viewing changes to a shared document in one object.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle R Stork whose telephone number is (571) 272-4130. The examiner can normally be reached on Monday-Friday (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (703) 308-5465. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Kyle Stork
Patent Examiner
Art Unit 2178

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PRIMARY EXAMINER